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IN THE
Supreme Court of the United States

No. 441, October Term, 1938

THE ELECTRIC STORAGE BATTERY CO.,
Petitioner,

VS.

GENZO SHIMADZU AND NORTHEASTERN
ENGINEERING CORPORATION
Respondents.

**BRIEF FOR RESPONDENTS IN OPPOSITION
TO PETITION FOR A WRIT OF
CERTIORARI**

✓ EDMUND B. WHITCOMB,
✓ GEO. WHITEFIELD BETTS, JR.
Counsel for Respondents.

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Opinions Below

The opinion of the District Court for the Eastern District of Pennsylvania (R. II, 1162-1189) is reported in 17 F. Supp. 42. A supplemental opinion of the District Court, not included in the record filed by petitioner, is reported in 36 U. S. P. Q. 25. The opinion of the Court of Appeals for the Third Circuit is reported in 98 F. (2d) 831.

JURISDICTION—REASONS OF THE CHARACTER ADVANCED BY PETITIONER FOR ISSUANCE OF WRIT OF CERTIORARI ARE INSUFFICIENT.

The judgment of the Circuit Court of Appeals affirming the decree of the District Court was entered August 8, 1938 (R. II, 1226). A petition for rehearing was denied September 14, 1938 (R. II, 1255). The petition herein was filed October 27, 1938, in which jurisdic-

tion of this Court is sought under §240 (a) of the Judicial Code, as amended. However, respondents submit that the instant case is merely "an ordinary patent case with the usual issues of invention, breadth of claims and * * infringement", which "this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent," **Keller v. Adams-Campbel Co.**, 264 U. S. 314, 319.

As only one Circuit Court of Appeals has passed on the patents here involved, there are no conflicting decisions on these same patents.

There are no special or important reasons for granting the writ sought as the case affects only the parties to this litigation. The case presents no conflict of opinion upon the same matter between two Circuit Courts of Appeals. The case presents no important question of federal law which has not been but should be settled by this Court; it presents no question of law important to the public as distinguished from the parties; it presents no conflict with any decision of this Court.

In fact, no real question of law is presented. Petitioner seeks merely a review of the facts.

STATUTES INVOLVED

Sections 4886, 4887, 4892, 4920 and 4923 of the Revised Statutes are quoted in the appendix.

STATEMENT

This suit was commenced in the United States District Court for the Eastern District of Pennsylvania for infringement of certain claims of patents Shimadzu Nos. 1,584,149, 1,584,150 and 1,896,020, and claims of three additional patents not now in controversy. The patents involve a highly meritorious process for making a fine lead powder by oxidation abrasion of metallic lead in a dry state, the powder being used in the manufacture of storage batteries.

The record establishes that the patentee's filing dates are January 30, 1922, July 14, 1923, and April 27, 1926, (the application of the later date being entitled to the date of the first cases), whereas the Hall patent, which represents the development of petitioner's alleged 1921 "knowledge and use," was not filed in the United States Patent Office until March 29, 1924. The record shows that many experiments were made by Hall from the time he began until October, 1923, (after Shimadzu's application for the '250 patent was filed).

Not until after October, 1923, (R. I., 467) did Hall arrive at a point in the development which would permit him to employ the invention successfully and economically. Prior to this time his experiments were in a direction which would never have led to success.

The District Court did not make a definite finding herein that production of the material by the process in question could be fixed as of June, 1921, the Court merely holding that such date "may" be so used. (R. II 1175). The Court of Customs and Patent Appeals, **Hall v. Shimadzu**, (1932,) 59 Fed. (2d) 225¹, in interference proceedings affirmed the Patent Office in holding that Hall, petitioner's employee, was unsuccessful in establishing conception or reduction to practice of the subject matter of the counts prior to Shimadzu's filing date.

However, on the facts of the record, it was concurrently found by the Courts below as follows: Respondent Shimadzu commenced his experiments in September, 1918, in Japan (R. II, 1163). The date of invention and successful reduction to practice is not later than August, 1919, (R. II, 1166).

1. That court stated, page 228:

"We are of the opinion that the Board of Appeals committed no error in finding"—"that the record is insufficient to establish conception or reduction to practice of the subject matter of the counts by appellant (Hall) prior to appellee's (Shimadzu) filing date.

"For the reasons stated the decision of the Board of Appeals in this interference is affirmed."

Although Shimadzu applied for and obtained several Japanese patents, only Japanese patent, No. 60,825, corresponds with United States patent No. 1,584,150, which was applied for within one year of the Japanese application date, and the lower Court so indicated (R. II, 1172).

The District Court carefully considered all the defenses including the prior patents, uses, etcetera, relied on by petitioner and held that they did not constitute anticipation of respondents' patents. The Circuit Court of Appeals, after outlining the scope of the issues presented to it for determination, adopted the opinion of the District Court holding for respondents.

SUMMARY OF ARGUMENT

This is an Ordinary Patent Case Not Involving any Special Matter Warranting Certiorari.

Petitioner's Point I, alleging confusion of the law, is not sound because no such conflict or disagreement in the courts below exists. In contests on priority between rival inventors for the establishment of one patent right, all courts have been consistent in excluding the introduction of fact testimony relating to acts done in a foreign country.

On the other hand, in infringement suits the courts have all consistently permitted an inventor, whether a citizen of the United States or foreigner, to show the true facts whether occurring in the United States or in a foreign country in proving his actual and not his artificial date of invention in order to overcome alleged prior uses and other defenses advanced by defendant.

As to petitioner's Point II based upon the alleged defense of public use, a defense which must not only be specifically pleaded but also proven beyond a reasonable doubt, respondents submit that petitioner being apprised of all the facts, did not plead public use in the answer or submit proofs thereon. Although the decisions below

refer to petitioner's "Hardinge mill" operations in 1921. As involving a "use" of plaintiffs' patents, the record shows in detail petitioner's subsequent extensive experiments bringing such experimental "uses" within the rule applied by the Court in **Elizabeth v. Pavement Co.**, 97 U. S. 126. Consequently, the courts below very specifically avoided any holding of public use in the statutory sense of the term. That the activities of petitioner referred to were private and not public is also evidenced by the fact that it required an order of the court before an inspection by the court's expert of petitioner's plant was allowed. (R. I., 2, 3).

Petitioner's Point III also relates to facts that were not pleaded in the answer, not urged in the District Court, and not proven by the record which on the contrary shows there was no suppression of the invention by the patentee. Petitioner is here again merely seeking to obtain a review of the facts in this case although the decisions of the lower courts are in no way inconsistent with any applicable decisions of this Court.

Respondents therefore submit that this is an ordinary patent case involving only fact questions of validity, scope of claims and infringement. These issues have been flatly resolved against petitioner by the concurrent rulings of the two courts below, a determination which, under the two-court rule applied by this Court, is not reviewable here. **Texas & N. O. R. Co. v. Brotherhood**, 281 U. S. 548, 556. There is no conflict with the decision of any other federal court as to the validity of the three patents here involved. Respondents perceive no ground upon which the present case can be differentiated from any other "ordinary patent case."

Lurking Questions

The questions (pet. 20-21) which petitioner says are so important that they should move this Court to grant certiorari—in the absence of a conflict as to the patents

involved—and present “a legal bewilderment upon an issue of broader public concern, it is believed, than that which arises when Circuit Courts of Appeals differ with respect to the construction or validity of the same patent”—are at best mere “lurking questions.”² Even if it could be said that the case genuinely involves all of the issues which petitioner asserts as reasons for granting the writ, the opinion of the District Court and that of the Circuit Court of Appeals will be read in vain for a discussion of these issues. Not once in the course of the District Judge’s opinion will a reference be found to R. S. §§4886, 4920 or 4923. R. S. §4887 is referred to only in connection with another issue quite apart from that now raised by petitioner. The embarrassment and confusion which petitioner indicates will follow the decisions below is, therefore, entirely improbable.

ARGUMENT

POINT I

There is no True Conflict between the Two Alleged Conflicting Groups of Cases Referred to by Petitioner. Both are in Harmony as They Apply to Different Sets of Facts.

On the one hand is the rule (A) as to whom of interfering contestants “priority of invention” shall be awarded and whether United States “patent rights” may be defeated by proof of unpublished activities in a foreign country (Sections 4886, 4923 R. S.).

On the other hand is the rule (B) that is applied in determining whether or not a United States patent granted on a foreign invention is valid as against an infringer’s assertion of prior knowledge and use or other defenses allowing patentee to show the actual, not artificial, date of invention to rebut such defenses.

2. Robertson and Kirkham, *Jurisdiction of the Supreme Court of the United States*, s304, p. 611, note 93, citing *Bingham v. United States*, 296 U. S. 211, 218, and *Webster v. Fall*, 266 U. S. 507, 511.

Main Statutes and Applicable Important Decisions.

The several sections of the Patent Acts should be taken together (**Gayler et al. v. Wilder**, 10 How. 477, 496).

R. S. 4886 (USC, Title 35, Sec. 31) states the conditions precedent to the grant of a valid patent, specifying in part that:

"Any person who has invented or discovered any new and useful art * * * not known or used by others in this country, before his invention or discovery thereof * * *"

is entitled to a patent. At the outset, it is important to note the significance of the words "Any person" which obviously includes either a citizen of the United States or of any foreign country. The Act of 1793 limited the right to obtain a patent to "citizens of the United States." The act of April 17, 1800, extended the privilege to "aliens, who, at the time of petitioning, had resided for two years within the United States," (48 C. J., 123.) In 1836 and in all amendments since, Section 4886 extended the privilege to "any person." Thus, the present statute granting the right to obtain a patent to "any person who has invented or discovered any patentable invention contains no limitation with respect to the citizenship of the inventor," (48 C. J. 123.) Moreover, this statute does not require that a person must have invented or discovered in the United States an art "not known or used by others in this country," nor does it require that the invention shall not be known or used by others in this country before his invention or discovery thereof in the United States. He must be the inventor of something which is not known or used by others in the United States at the date of his invention or discovery irrespective of the country in which the invention or discovery was made. Respondents rely on the right granted in Section 4886 to show the actual date of invention.

Moreover, as a condition precedent to the grant of a valid patent, the applicant must make oath as required by R. S. 4892 (USC, Title 35, Sec. 35) which includes;

"The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art * * * for which he solicits a patent; that he does not know and does not believe that the same was **ever** before known or used."

Again, there is no qualification as to place in which the invention is made but the applicant, to obtain a valid patent, must assert the belief that he was the first and original inventor of that which was not known or used before the date of his invention.

Reference is also made to R. S. 4920 (USC, Title 35, Sec. 69) expressly providing as the fourth defense:

"That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented;"

as this in effect corresponds to the condition precedent required by R. S. 4886 and of the allegation contained in the oath required by R. S. 4892.

Petitioner has referred to (Footnote, p. 19 of Petitioner's Brief) and respondents primarily rely upon the cases arising under the foregoing sections of the statute which have permitted a United States patentee, whose invention was made abroad, to show the actual facts as to his dates of invention, as distinguished from the artificial date of invention on which he filed a corresponding application for patent in a country foreign to the United States. All the cases in this group are in perfect harmony.

Petitioner also refers to Section 4923, but respondents submit the same obviously does not here apply. The

* Emphasis in all quotations is ours unless otherwise expressly noted.

very title of this section shows that it relates to an entirely different subject—"Patent not void for previous use of thing in foreign country."

This section is only intended to render a knowledge or use in a foreign country ineffective to invalidate a patent once granted in the United States, regardless of whether the inventor of the patent in question was a citizen of the United States or a foreigner. The provisions of this section make it clear that unpatented or unpublished uses or knowledge in foreign countries shall not be available to invalidate a United States patent.

However, in view of R. S. 4886, as now amended, to include the words "in this country" after the words "not known or used by others" apparently R. S. 4923 is merely repetitious and respondents agree with petitioner in its statement in the footnote in the appendix that insofar as affecting determination of validity of patents once granted "It would seem that R. S. 4923 has now become *functus officio*."

Cases Under Group (A)—Petitioner's Erroneous Attempt to Show Conflict.

Petitioner has attempted to classify the instant case under R. S. 4887 (USC, Title 35, Sec. 32) only, but respondents maintain that this statute merely refers to the right of a foreign inventor to obtain the benefit of his foreign filing date under the International Convention which is wholly aside from his right to also show actual dates of invention in an infringement suit. Thus, R. S. 4887 contains two distinct provisions. The first paragraph prescribes that the patent granted in this country shall not be defeated by a like patent granted in a foreign country to the same inventor at an earlier date if the United States application is filed within twelve months of the application date of the said foreign patent. This paragraph of R. S. 4887 is not here involved, as Shimadzu's United States application was filed within the

year of his related Japanese application in the only instance of correspondence between Shimadzu's United States and foreign patents.

Referring to the second paragraph of R. S. 4887 particularly relied upon by petitioner in its Reason I, attention is called to the fact that this entire paragraph is limited to patent "applications" in contradistinction to paragraph one which includes both patent applications in United States Patent Office and also deals with "patents" already granted. Petitioner's attempt to imply that consequently other acts relating to facts of priority, such as conception, diligence and actual reduction to practice cannot be shown is wholly unwarranted in view of the rule of law that courts should be extremely careful not to add anything to a statute by interpretation which was omitted therefrom by Congress. See **Lake County v. Rollins**, 130 U. S. 662, 670; **Treat v. White**, 181 U. S. 264, 267; **Dewey v. United States**, 178 U. S. 510, 521, where this Court stated:

"Our province is to declare what the law is, and not, under the guise of interpretation or under the influence of what may be surmised to be the policy of the Government, so to depart from sound rules of construction as in effect to adjudge that to be law which Congress has not enacted as such. Here, the language used by Congress is unambiguous. It is so clear that the mind at once recognizes the intent of Congress. Interpreted according to the natural import of the words used, the statute involves no absurdity or contradiction, and there is consequently no room for construction. Our duty is to give effect to the will of Congress, as thus plainly expressed."

The second paragraph of R. S. 4887 relates only to the right in a foreign inventor to rely on his convention date for certain purposes, and obviously purposely does not prohibit or relate to the right of the patentee in patent infringement suits to show the actual, not artificial,

date of invention by conception, diligence and actual reduction to practice either in the United States or in any foreign country, a right clearly permitted under Section 4886 to allow an inventor to defend his patent. It is therefore respectfully submitted that all the cases cited by petitioner on pages 14 through 17 relate fundamentally to the administrative rule or to a contest on "priority of invention" and come within category of rule (A) *supra* rather than in the class of cases category of rule (B) relied upon by respondents.

The three cases of **Electrical Accumulator Co. v. Julien Electric Co.**, 38 F. 117, **Brush Electric Co. v. Julien Electric Co.**, 41 F. 679, and **Electrical Accumulator Co. v. Brush Electric Co.**, 52 F. 130, should be considered together because, insofar as here concerned, they also deal with a "priority of invention" as between Brush, a citizen of the United States, and Faure, a citizen of France. Interferences had been set up in the Patent Office and decided in favor of Brush (38 F. 130; 41 F. 686; 52 F. 134). In the earliest of these three suits (38 F. 117) suit was brought on the Faure United States patent and Brush was set up as the prior inventor (p. 128); the Court found that Brush was prior to Faure, as had been done in the Patent Office (p. 130), and restricted Faure to the issue date of his French patent for his date of invention—as would have been done in the Patent Office during the interference. In the second and third of these cases (41 F. 679 and 52 F. 130) the Brush patents were in suit and the Court ruled in favor of Brush on the contest of rival claimants for determination of "priority," ruling in effect that Faure's work in France could not defeat Brush's United States patent, as provided by R. S. 4923 in the absence of a patent or printed publication. Thus these cases are not concerned with the question in the instant case of a plaintiff patentee proving that he is *defacto* the first inventor against the attack of an infringer. In the first of these cases the question was real-

ly an issue involving rival claimants for the same patent on priority of invention and the court merely followed the conclusion of the Patent Office that as between Faure and Brush, Brush was *de jure* the first inventor. There is no indication of any attempt to introduce any fact testimony with respect to conception and actual reduction to practice of the inventions abroad in contradistinction to mere reliance on Faure's foreign patent date. These Faure and Brush cases were clearly distinguished by Judge Dallas in **Hanifen v. E. H. Godshalk**, 78 Fed. 811 (pgs. 812, 813) on the ground that where the contest was one of priority of invention as between Brush and Faure the Patent Office rule should be followed, whereas on the other hand, under Section 4886 where the alleged anticipatory knowledge and use is not being advanced as the basis for patent rights inuring to such user, the plaintiff patentee is permitted to show that he is *defacto* the first inventor when the validity of his patent is attacked by an infringer. Thus, in the **Hanifen v. E. H. Godshalk** case, *supra*, Judge Dallas correctly made this finding (page 814):

"It was competent for the complainant to prove the actual date with reference to the invention made in England."

In the instant case, the fact that Hall (and consequently petitioner) disclaimed the broad claims following their final defeat in the interference is conclusive against allowing petitioner to claim that there is now in fact any contest of priority between rival claimants for the same patent rights here involved.

Again, the two cases of **Vacuum Engineering Co. v. Dunn**, 209 F. 219, C. C. A. 2 and **Patents Selling & Exporting Co. v. Dunn**, 213 F. 40, C. C. A. 2 should be considered together. In the former, suit was brought on the Locke and Dunn patent, and the Schiodt patent was set up as a defense. Schiodt having made his invention in a foreign country, the Court held that knowledge of the

Schiodt invention abroad could not be used because its effect would be to defeat the Locke and Dunn patent prohibited under R. S. 4923. No such condition exists in the instant case as Shimadzu is not attempting to defeat Hall's patent. In the second of these cases suit was brought on the Schiodt patent, and having previously held in the first of these cases that Locke and Dunn were prior to Schiodt, the Locke and Dunn patent was treated as prior art to Schiodt. Thus these two cases again involved, in effect, a contest of priority between Locke and Dunn and Schiodt, and the Court first upheld the Locke and Dunn patent against the attack thereon based on Schiodt's foreign work as required by R. S. 4923. It is important to note that the Second Circuit Court of Appeals in the **Patent Selling & Exporting Co. v. Dunn, supra**, on a motion to amend the mandate stated that it could be amended without prejudice "to introduce further proofs as to priority of invention" when the case was remanded. Again, attention is called to the fact that ultimately a petition to recall the mandate in the first Dunn case, **Vacuum Engineering Co. v. Dunn, supra**, was allowed by the Second Circuit of Appeals reported in 218 Fed. 991.

In **Jay v. Weinberg**, 250 F. 469, D. C. N. D. Ill., the Court held that the Higginson and Arundel patent was entitled to the filing date of the corresponding British application, citing *inter alia* **Welsbach v. American and Badische v. Klipstein, supra**, which held that a plaintiff patentee, as against an infringer, may prove his work abroad to establish that he is *de facto* the first inventor.

The decision of the court (from which no appeal was taken) in the case of **Ireson v. Pierce**, 39 F. 795, cited by petitioner does not conflict with the foregoing. In the Ireson case no fact testimony relating to the actual development of the invention was introduced. The plaintiff attempted to prove priority of invention over an English patent to Howe not by showing actual facts of the mak-

ing of an invention but merely by reliance upon an English provisional specification. Of course, the same was not "patented or described in any printed publication," (Sections 4886, 4920 and 4923). The Court merely held that the English provisional specification was not a printed publication within the meaning of the statute.

In addition, it is important to note that in the year 1889, the date of the Ireson decision, Section R. S. 4886 did not include the phrase "before his invention or discovery thereof" in specifying the critical date before which an alleged defense of "prior knowledge and use" must be proven nor did it include words limiting the use to one occurring in "this country." These changes in the statute were introduced by amendment of 1897, effective January 1, 1898 (35 U. S. C. A., pages 11, 12).

Moreover, the Second Circuit Court of Appeals in **Welsbach Light Co. v. American Incandescent Lamp Co.**, hereinafter more fully discussed, specifically distinguished *inter alia* the Ireson case from its decision on the grounds that the Ireson case related to a contest between original inventors of priority of invention in contradistinction to a suit by a patentee against an infringer. In such a case, the patentee may show the actual and not artificial date of his invention in order to avoid an alleged defense of prior use in this country.

Group (B) Cases Sustaining Right of Patentee to Defend his Patent by Foreign Fact Testimony Against Attack by Infringer are Not Inconsistent with the Foregoing Cases of Group (A).

The instant case comes under the category of rule (B) cases *supra* as it is concerned with the right of an inventor to introduce proofs in defense and support of the patents where the invention was made abroad when its validity is attacked by an infringer. He is entitled to prove that he is *de facto* the first inventor as required by R. S. 4886 and as alleged in the oath required of him under R. S. 4892. The cases have uniformly so held.

Hanifen v. E. H. Goddshalk Co., 78 F. 811, C. C. E. D. Penn., (reversed on other grounds 84 F. 649, C. C. A. 3); **Hanifen v. Price**, 96 F. 435, C. C. S. D. N. Y. (reversed on other grounds, 102 F. 509, C. C. A. 2; and affirmed on certiorari by a divided Court, 186 U. S. 481); **Welsbach Light Co. v. American Incandescent Lamp Co.**, 98 F. 613, C. C. A. 2; **Badische Anilin & Soda Fabrik v. A. Klipstein & Co.**, 125 F. 543, C. C. S. D. N. Y.; **Claude Neon Lights, Inc., v. Rainbow Light, Inc.**, 47 F. (2d) 345, D. C. E. D. N. Y. A summary of this rule of law is aptly stated by the court in the **Claude Neon v. Rainbow Light** case last referred to; that court stated, 47 Fed. (2nd) 345, 346, as follows:

"The plaintiffs have the right as against an infringer to carry the date of invention of the patent in suit back of its convention date by proof of acts abroad.

"Section 4886 of the Revised Statutes of the United States, now title 35, §31, U. S. Code (35 USCA §31), relating to the grant of patents, reads as follows: (quoting statute).

"That statute is not limited to inventions made in the United States. See Walker on Patents (6th Edition) §109, p. 136):

"When a patent is questioned in point of novelty, and when that question depends upon the date of the invention claimed in that patent, it is not material whether the event, which constituted that invention, occurred in the United States or in some other country.' **Welsbach Light Co. v. American Incandescent Lamp Co.** (C. C. A.) 98 F. 613, at page 615; **Hanifen v. E. H. Goddshalk Co.** (C. C.) 78 F. 811, at page 812; **Hanifen v. Price** (C. C.) 96 F. 435, at pages 440 and 441; **Badische Anilin & Soda Fabrik v. A. Klipstein & Co.** (C. C.) 125 F. 543; **Hanifen v. Price** (C. C. A.) 102 F. 509.

“Defendant’s comment on the two Hanifen cases cited, that they were decisions of District Courts and both were reversed upon appeal, does not convince me that they incorrectly state the law, for the reason that such reversals were on other grounds; and, while it is true that in one of the two cases the District Judge reversed himself on rehearing, he did not reverse his former ruling that the patentee of the patent in suit had the right to carry his date of invention back to the date of his inventive act.

“Welsbach Light Co. v. American Incandescent Lamp Co., supra, and Badische Anilin & Soda Fabrik v. A. Klipstein & Co., supra, do support the plaintiff’s view, because, even if the comment in the Welsbach Case was obiter, the decisions show that the plaintiffs may carry the date of invention in a foreign country back of the date of convention, even if in the two cases last cited the date was only carried back to the filing date in the foreign country.”

The Circuit Courts of Appeals Have Announced and Maintained This Sharp Line of Distinction Between the Group (A) and Group (B) cases.

In distinguishing the type of case here involved from the type of case involving an issue of priority, the Court of Appeals of the Second Circuit in **Welsbach Light Co. v. American Incandescent Lamp Co., supra**, said (page 615):

“This is not the case of an interference in the Patent Office, or of a contest in the courts between two original inventors for priority of invention, in which it is the established rule, under section 4923, Rev. St. U. S., that an original inventor, who applies for letters patent of the United States, cannot be deprived of his right to a patent by the fact that an inventor had made in a foreign country, at a prior

date, the same original invention, but which had not been described at a prior date in a patent or in a printed publication."

After quoting R. S. 4886, the Court said:

"The theory of the defendant is that, as to the domestic inventor, knowledge in this country must precede the actual date of the invention, but that, as to a foreign inventor, knowledge in this country need only precede the date of the publication of his foreign patent. We are of opinion that the language of the section refers to the actual, and not an artificial, date, and that, where there is no contest between inventors, if knowledge in this country did not precede the actual date of the invention, unless it had been used in this country for two years before the application, the inventor was entitled to a patent."

This principle was followed and applied in **Badische v. Klipstein**, *supra* (page 552), and in **Claude Neon Lights v. Rainbow Light**, *supra* (page 346).

In **Hanifen v. Price**, *supra*, the Court after noting the rule to be applied in interference practice said: (p. 441)

"There is, however, a distinction between the provisions of section 4923, which provides for the protection of the patentee against proof of prior knowledge, or use of his invention without publication in a foreign country, and the general grant by section 4886 of the right to a patent to any person who has made an invention not known or used by others in this country, and nowhere patented or described in any printed publication."

After quoting from R. S. 4886, the Court continued:

"The natural interpretation of this language would indicate an intention to confer the benefit of the patent law upon any individual who could show

a prior completed inventive conception, regardless of the place where the invention was conceived *. There is no expressed limitation as to time or place of invention, or of citizenship of the inventor, so far as his rights under section 4886 are concerned."**

Thus, respondents strenuously urge that petitioner has cited no cases nor have respondents been able to find any showing any conflict with this rule which was followed in the Courts below. On the contrary, there is a recognition by the Courts of two different rules which govern two different sets of facts, and petitioner's real complaint, therefore, is that the Courts below have found the facts to be within one rather than the other of the two rules and, in applying the applicable rule, upheld the patents.

POINT II

In failing to find that there was a prior "public use" of the inventions here in issue within the meaning of R. S. 4886 and R. S. 4887 the Courts below have not decided a federal question in conflict with applicable decisions of this Court or a Circuit Court of Appeals.

The facts of the record completely fail to prove any statutory bar of "public" use. However, at the outset we desire to point out that petitioner did not plead in its answer any such defense, nor did it serve notice of this defense as required under R. S. 4920. The failure to comply with the statutory prerequisites should prevent petitioner from urging this belated defense. **Angle et al v. Richardson**, 19 Fed. Sup. 1002, 1004. In any event this Court has denied certiorari under these circumstances. **The Byrne Manufacturing Company v. American Flange & Manufacturing Co., Inc.**, 58 Sup. Ct. 18.

The question of prior use in this case is one of fact which, having been resolved in respondents' favor by concurrent findings of the courts below, is not properly a ground of review by this petition in this court. In Gen-

eral Talking Pictures Corp. v. Western Electric Co., et al, 304 U. S. 175, 178-179, this Court stated:

"Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it. **Southern Power Co. v. N. C. Public Service Co.**, 263 U. S. 508. **United States v. Johnston**, 268 U. S. 220, 227. Moreover, the decision on that point rests on concurrent findings. They are not to be disturbed unless plainly without support. **United States v. Chemical Foundation**, 272 U. S. 1, 14. **United States v. McGowan**, 290 U. S. 592. **Alabama Power Co. v. Ickes**, 302 U. S. 464. There is evidence to support them. Nor would the writ be granted to review the questions of anticipation and invention that petitioner argues, for as to them there is no conflict between decisions of circuit courts of appeals. **Layne & Bowler Corp. v. Western Well Works**, 261 U. S. 387, 393. **Keller v. Adams-Campbell Co.**, 264 U. S. 314, 319-320. Cf. **Stilz v. United States**, 269 U. S. 144, 147-148."

Petitioner's claim that the lower court's simultaneous holding with respect to petitioner's "Hardinge mill" activities in 1921 and with respect to the validity of patents in suit constitute a conflict with applicable decisions of this Court is unwarranted because the lower courts, from a consideration of the entire record, concurrently found that no such use existed within the meaning of Sections 4886 and 4887. Petitioner's activities with the "Hardinge mill" being of an experimental nature were properly regarded by the lower courts as not constituting a public use in accordance with the rule of this Court enunciated in the case of **Elizabeth v. Pavement Company**, 97 U. S. 126, 134, 135.

Petitioner's process was developed in its plant by its engineer Hall. In his applications for United States patents (P. X. 17, 18) which he filed in March, 1924, and in his preliminary statements filed in the Hall-Shimadzu

interference (P. X. 41, pp. 13, 14 and 18), Hall swore that the inventions had not been in public use for more than two years prior to his filing date. Hence, petitioner, who is in privity with Hall, obviously cannot now contend that the inventions were in public use in 1921.

The Courts below in refusing to find prior "public use" and in sustaining the patents have not decided any questions in conflict with applicable decisions of this Court or other Circuit Courts of Appeals. None of the cases cited in petitioner's brief under Point II sustains petitioner's contentions. On the contrary, those cases sustain the proposition that if an invention is publicly used for more than two years prior to the filing date of an application for a patent, such use is a bar to the issuance of a patent thereon. Respondents have no quarrel with the principles expounded in those cases.

None of the authorities cited by the petitioner sustains the proposition that where there are concurrent findings in the courts below on an issue of fact, such as prior "public use," such decisions are open to review in this Court. In all of the cases cited, this Court merely affirmed the findings of the Courts below on this question. No possible conflict, therefore exists between the instant case and these cited decisions.

POINT III

Suppression of inventions during which intervening rights have accrued warranting estoppel against Shimadzu to prove true dates of invention not shown and there is no conflict as to the law applicable.

In connection with the facts relied upon by petitioner stated in Point III, attention is called to the fact that such alleged defense was not pleaded in petitioner's answer nor urged in the trial court. Hence, respondents' arguments under Point II with respect to petitioner's failure to plead public use apply with equal force against petitioner's Point III.

Shimadzu made no suppression of the inventions but subsequent to his reduction to practice in August, 1919 he installed new mills, built a new plant and therein was continually further improving the commercial and economic efficiency thereof up until 1924 as shown by Ishimura's Notebooks (P. X. 7 and 8).^{*} Simultaneously with this commercial activity Shimadzu filed applications in Japan and many other countries in the world on various stages and features which he believed patentable. Thus, on December 17, 1920, he filed in the United States application Serial No. 431,473, and it is important to note that the United States Patent Office allowed him to state in the specification of the '150 patent that such application was "a continuation in part of application Number 431,473, filed December 17, 1920." The application for patent No. 1,584,149 was filed January 30, 1922, while the application for Shimadzu patent No. 1,584,479 was filed February 20, 1923. It is also important to note that the application 431,473 filed December 17, 1920; was co-pending and overlapping with the filing of the application for patent 1,584,479 filed February 20, 1923, and patent 1,584,150 filed July 14, 1923. Certainly this activity, both from a commercial aspect and from an attempt to obtain patents, could not be described as any deliberate suppression of the inventions in issue.

The question of suppression by respondent Shimadzu is one of fact. Both of the Courts below concurrently resolved this issue in respondents' favor and is therefore not properly a question for review in this Court on certiorari. **General Pictures Co. v. Electric Co.**, 304 U. S. 175, 178, 179.

Hence, the facts and findings do not support petitioner's charge of suppression. The statements made by this Court in **Kendall v. Winsor**, 21 How. 322, 328, referred to by petitioner, instead of supporting petitioner's contention, actually show that Shimadzu acted wholly

** Translations (Eps. 7a + 8a)*

within the latitude of law allowed in connection with filing of patent applications. In that case, this Court stated:

"But the relation borne to the public by inventors, and the obligations they are bound to fulfill in order to secure from the former protection, and the right to remuneration, by no means forbid a delay requisite for completing an invention, or for a test of its value or success by a series of sufficient and practical experiments; nor do they forbid a discreet and reasonable forbearance to proclaim the theory or operation of a discovery during its progress to completion, and preceding an application for protection in that discovery. The former may be highly advantageous, as tending to the perfecting the invention; the latter may be indispensable, in order to prevent a piracy of rights of the true inventor."

CONCLUSIONS

The decision below is unquestionably correct. It rests upon well settled principles of law entirely in harmony with applicable decisions of this Court.

The questions presented by the petition are almost exclusively questions of fact limited to this particular case. No question of general importance is involved. There is no conflict between Circuit Courts of Appeals on the patents in suit. The lower court has decided no important federal question in conflict with any of the decisions of this Court or any other Circuit Courts of Appeals; nor has it decided any federal question requiring settlement by this Court. On the contrary, the lower court's decision follows the settled practice.

The petition for writ of certiorari should be denied.

Respectively submitted,

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GEO. WHITEFIELD BETTS, JR.

Counsel for Respondents.

Dated: November 18, 1938

APPENDIX

Containing Revised Statutes 4886 (U. S. C., Title 35, sec. 31); 4887 (U. S. C., Title 35, sec. 32); 4892 (U. S. C., Title 35, sec. 35); 4920 (U. S. C., Title 35, sec. 69); 4923 (U. S. C., Title 35, sec. 72):



Section 31. Inventions Patentable.

Sec. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

Section 32. Inventions Previously Patented Abroad

Sec. 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and six months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an appli-

ation for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privilege to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within six months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing.

Section 35. Oath of Applicant.

Sec. 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, or of the variety of plant, for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of

the United States, or before any notary, public judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States.

**Section 69 Pleading and Proof in Action
for Infringement.**

Sec. 4920. In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

* * * * *

**Section 72. Patent Not Void for Previous
Use of Thing in Foreign Country**

Sec. 4923. Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication.

